

Appl. No. 10/719,871
Amdt. Dated August 19, 2010
Reply to Office action of February 19, 2010

RECEIVED
CENTRAL FAX CENTER

AUG 19 2010

PATENT AF
RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
ART UNIT: 2625

REMARKS/ARGUMENTS

Applicants thank the Examiner for the careful consideration given the present application, and respectfully request favorable reconsideration of the application in view of the comments set forth below.

Interview Summary – 37 C.F.R. §1.133

Applicants thank the Examiner for taking the time to speak with Applicant's representative, Donald J. Firca, Jr., on July 22, 2010. During the telephone interview the Examiner agreed that the finality of the current Office action was improper, and agreed to enter the amendment without requiring a RCE.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1, 5-6, 9, 13-14, 17-22, 26, 28-30, 35 and 39-40 stand rejected under 35 U.S.C. §103(a) as being Unpatentable over Currans *et al.* (US 6,731,393) (hereinafter "Currans") in view of Kassmann (US 6,657,742) (hereinafter "Kassmann"). However, Applicants respectfully submit that the combination of Currans in view of Kassmann fails to teach every feature of the invention recited in claims 1, 9, 17, 28 and 35.

CLAIMS 1, 9 AND 35

Regarding claims 1, 9 and 35, Currans and Kassmann both fail to teach, suggest or otherwise render predictable receiving, at a printer, a print client indicator comprising existing information typically not used to determine media selection parameters. The Office action cites the existence of a user 20330/user ID 606 and a user name 604 in Currans as teaching such a feature, but Currans does not teach receiving any of this information at a printer. According to Currans, the user profile data structure 602 is maintained and continuously updated to reflect the user's interests, thereby allowing an electronic publication specific to the user's interests to be generated and electronically transmitted to the user via the document delivery system. See, e.g., Currans, col. 8, lines 34-47. Currans is silent about receiving any of this information at the

Appl. No. 10/719,871
Amdt. Dated August 19, 2010
Reply to Office action of February 19, 2010

PATENT AF
RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
ART UNIT: 2625

printer as a "print client indicator" as claimed. And Kassmann describes the use of explicit media selection parameters, see, Kassmann, col. 11, lines 43-47, which is the opposite of a print client indicator comprising existing information typically not used to determine media selection parameters.

Further with regard to claims 1, 9 and 35, Currans and Kassmann also fail to teach selecting at least one of the final media selection parameters based on the existing information that is typically not used to determine media selection parameters. The Office action cites col. 18, lines 23-25 and fig. 3 of Currans as teaching such a feature. However, this portion of Currans describes monitoring the user profile (stored in the knowledge module 170) to determine whether a "product subsidy" should be sent to the user. An example of a product subsidy is an ink cartridge. According to Currans, when the user has printed a predetermined number of copies of an advertisement, the user is given the ink cartridge (i.e., product subsidy) as a gift in appreciation of the user printing so many advertisements. The product subsidy is subsidized by advertising revenue or funded by content providers as marketing costs. See, e.g., col. 3, lines 40-45. Currans is silent about selecting a final media selection parameter to be used to select a medium on which a print job is to be performed as claimed.

Currans and Kassmann also fail to teach selecting a final media selection parameter as claimed in claims 1, 9 and 35. The Office action cites a portion of Currans (col. 5; lines 25-35) as selecting a media selection parameter, but this portion of Currans simply describes a printer capable of printing on different media. Nothing in this portion of Currans explains the process of selecting final media selection parameters, much less selecting a final media selection parameter based on the existing information as the print client indicator according to the claimed comparing, determining and outputting steps.

Currans and Kassmann also fails to teach determining if a matching entry including the print client indicator exists in the mapping module. The Office action merely explains that the user profile information data structure 602 includes a user name field 604 and user id field 606, but fails to cite anything in Currans that amounts to a comparison of this entry to entries in a mapping module. Currans is admitted in the Office action as failing to teach comparing the print client indicator to a plurality of entries in a mapping module. But Currans is then cited as

Appl. No. 10/719,871
Amdt. Dated August 19, 2010
Reply to Office action of February 19, 2010

PATENT AF
RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
ART UNIT: 2625

teaching the step of determining if a matching entry exists. Applicants respectfully submit that since no comparison is performed in Currans, Currans also does not teach determining whether a matching entry exists.

Specifically regarding claims 1 and 9, the combination of Currans and Kassmann also fails to teach, suggest or otherwise render predictable that the existing information making up the print client indicator is information in the communication protocol. For example, an embodiment of the existing information in the communication protocol is described as a TCP port number, network address, etc... Based on such existing information in the communication protocol the final media selection parameters can be selected. Thus, even assuming for the sake of argument that the user 20330/user ID 606 and a user name 604 in Currans amount to a print client indicator, which Applicants do not concede, such information would not be information in the communication protocol as required by claims 1 and 9.

For at least the above reasons, the combination of Currans and Kassmann fails to teach every limitation found in claims 1, 9 and 35 as required to maintain a rejection of those claims under 35 U.S.C. §103(a). Further, since claims 5-8 depend from claim 1, claims 13-14 depend from claim 9 and claims 39-40 depend from claim 35, those claims are also not rendered unpatentable by the combination of Currans and Kassmann for the purposes of 35 U.S.C. §103(a).

CLAIMS 17 AND 28

Regarding claims 17 and 28, Currans and Kassmann both fail to teach, suggest or otherwise render predictable a printer including a decoding module for extracting a print client indicator comprising existing information in the communication protocol utilized to send the print job to the printer that is typically not used to determine media selection parameters. For example, an embodiment of the existing information in the communication protocol is described as a TCP port number, network address, etc... It is this communication-protocol existing information that is extracted as the print client indicator by the decoding module for selecting the final media selection parameters. Thus, even assuming for the sake of argument that the user 20330/user ID 606 and a user name 604 in Currans amount to a print client indicator, which

Appl. No. 10/719,871
Amdt. Dated August 19, 2010
Reply to Office action of February 19, 2010

PATENT AF
RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
ART UNIT: 2625

Applicants do not concede, such information would not be information in the communication protocol as required by claims 17 and 28. Currans does not teach extracting this information or a decoding module for performing this extraction. According to Currans, the user profile data structure 602 is simply maintained and continuously updated to reflect the user's interests, thereby allowing an electronic publication specific to the user's interests to be generated and electronically transmitted to the user via the document delivery system. See, e.g., Currans, col. 8, lines 34-47.

Further with regard to claims 17 and 28, Currans and Kassmann also fail to teach a parameter determination module to output at least one of the final media selection parameters based on the existing information that is typically not used to determine media selection parameters. For reasons analogous to those above for claims 1, 9 and 35, Currans describes monitoring the user profile (stored in the knowledge module 170) to determine whether a "product subsidy" should be sent to the user. An example of a product subsidy is an ink cartridge. According to Currans, when the user has printed a predetermined number of copies of an advertisement, the user is given the ink cartridge (i.e., product subsidy) as a gift in appreciation of the user printing so many advertisements. The product subsidy is subsidized by advertising revenue or funded by content providers as marketing costs. See, e.g., Currans, col. 3, lines 40-45. Currans is silent about a parameter determination module for outputting a final media selection parameter to be used to select a medium on which a print job is to be performed as claimed. And Kassmann describes the use of explicit media selection parameters to select a medium, see, Kassmann, col. 11, lines 43-47, which is the opposite of a print client indicator comprising existing information typically not used to determine media selection parameters.

Currans and Kassmann also fails to teach a parameter determination module for determining if a matching entry including the print client indicator exists in the mapping module. The Office action notes the absence of the module for performing the comparison from Currans. The cited portions of Kassmann, however, describe checking the attributes of the media trays correspond with the media selection parameters specified in the print job. However, the media selection parameters in the print job in Kassmann have already been selected prior to this check. Further, the media selection parameters are explicitly defined as such in Kassmann, and are not print client indicators compared in a mapping module as claimed.

Appl. No. 10/719,871
Amdt. Dated August 19, 2010
Reply to Office action of February 19, 2010

RECEIVED
CENTRAL FAX CENTER

AUG 19 2010

PATENT AF
RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
ART UNIT: 2625

For at least the above reasons, the combination of Currans and Kassmann fails to teach every limitation found in claims 17 and 28 as required to maintain a rejection of those claims under 35 U.S.C. §103(a).

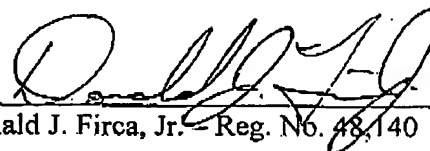
The remaining claims in the present application are allowable for the limitations therein and for the limitations of the claims from which they depend.

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. CODO-45537.

Respectfully submitted,
PEARNE & GORDON, LLP

By:


Donald J. Firca, Jr. - Reg. No. 48,140

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: August 19, 2010